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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       |
|-----------------|-------------|----------------------|---------------------------|
| 08/914,536      | 08/19/97    | STEVENSON            | M STEVE-106 <sup>mk</sup> |

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IM22/0723

| EXAMINER   |              |
|------------|--------------|
| CAMERON, E |              |
| ART UNIT   | PAPER NUMBER |
| 1762       | 21           |

DATE MAILED: 07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

08/914,536

Applicant(s)

STEVENSON ET AL.

Examiner

Erma C. Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 47-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 47-55 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the composition as claimed in Claim 1 as originally filed, does not reasonably provide enablement for the broader composition of Claim 47. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

There is no evidence that limitations outside the scope of the originally filed claim 1 would be operative in the claimed invention.

2. Claim 47 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New matter: the following is considered to be new matter, not supported by the specification as originally filed:

a) Claim 47: "...powder that is adapted to fuse into and form a permanent bond of the decorative enhancement composition as a whole..."

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The examiner cannot find where in the specification as originally filed this statement is made, in particular the expression "as a whole", and that the powder forms a permanent bond..

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 47-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 47: it is not clear what is meant by "...powder that is adapted to fuse into and form a permanent bond of the ...composition as a whole with the molded polyethylene article...". What is the powder fusing into, the composition or the article? And how does the powder form a bond of the composition with the article?

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/23041.

'041 teaches a thermoplastic spray material for bonding to polyethylene (p4) where the composition comprises 5-95% polyethylene powder with particle size less than 50 microns (p18-19), organic or inorganic pigments or mixtures, organic solvents or water or mixtures (p19), and resin particles such as rosins or hydrocarbon resins (p21). After application to a surface, the composition is heated (p20).

The composition of '041 overlaps with applicant's claimed ranges.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. See *In re Malagari* 182 USPQ 549.

'041 does not teach a clear overcoat, but a color-plus-clear type of surface coating is conventional to the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a protective clear overcoat to the pigmented coating of '041, for protection.

The present application is not entitled to the filing date of 08/566906 because the present application recites a coating composition and process (20-90 percent liquid carrier, 9-50 % colorant + 50-91 % of binder and particulate thermoplastic powder , to be applied to a preformed

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molded article (2:1-12)) that is different from that of 08/566906 (thermoplastic or thermosetting resin, liquid carrier, binder solid and optional colorant, to be applied to a mold surface). See MPEP 201.11.

The applicant has presented no arguments regarding this rejection in the 7/11/2001 amendment.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma C. Cameron whose telephone number is 703-308-2330. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-872-9475 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Erma Cameron*  
**ERMA CAMERON**  
**PRIMARY EXAMINER**

Erma C. Cameron  
Primary Examiner  
Art Unit 1762

July 22, 2001